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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,141	11/26/2003	Jeffrey M. Wendlandt	6530.0272-01	2752

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EXAMINER

HOANG, TU BA

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,141

Applicant(s)

WENDLANDT ET AL.

Examiner

Tu Ba Hoang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-69 is/are pending in the application.
- 4a) Of the above claim(s) 50-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 45-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Response to Amendment

Applicant's arguments, see the Remarks on page 8, filed April 13, 2005, with respect to the rejection(s) of claim(s) 1 under nonstatutory double patenting over claims 1 and 14 of Wendlandt et al (US 6,736,773) and under 35 USC 102(b) by each of De Faria-Correa et al., Hassler, and Thompson have been fully considered and are persuasive in lieu of the cancellation of claim 1. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made to the newly added claims 45-69 as follow:

Election/Restrictions

Newly submitted claims 50-69 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: endoscopic system of newly added claims 50-54 require and "a vision head connected to a distal end of the extension arm, a distal face of the vision head including a distal chip and being configured to obtain a forward-looking image when the head is adjacent to the distal end of the endoscope, and a proximal face of the vision head including a proximal vision chip and being configured to obtain a backward-looking image when...", newly added claims 55-69 require a vision chip at the distal end of the endoscope with a mirror being extendable and rotatable while in the original claim 1, a vision member does not need to be a mirror and can be extendable but may not be rotatable. Newly added claims 66-69 were directed to a method for obtaining images of a surgical site, in which a vision head and the distal end of the endoscope are placed into a body lumen while in the system recited in the newly added claims 45-49, they can be placed anywhere for obtaining images. Since claim 1 is the most generic claim for at least newly added claims 45-49. The Examiner position is that claims 45-49 are directed to the same invention defined by the original claim 1.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 50-69 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.. As the election has been treated as an election without traverse and therefore the requirement is still deemed proper and is hereby made FINAL. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45-49 are rejected under the judicially created doctrine of double patenting over claims 1 -8 of U. S. Patent No. 6,736,773 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: "a vision head attached to a distal end of the extension arm wherein the vision head includes a vision *chip for obtaining an image*". Although the conflicting claims are not identical, they are not patentably distinct from each other because the recited "a vision head being configured to extend away from the distal end of the endoscope to permit retrograde vision" in claim 45 of the present application would be in either the inherency or in the equivalence of the recitation of the "a head attached to a distal end of the extension arm, the head being articulatable relative to the extension arm and including a vision chip capable of receiving an image" (in claim 1 of the patent). The recitation of "at least two lumens" in claim 45 of the present application would obviously be within the purview of obviousness of the "channel" recited in claim 1 since "channel" may include more than one lumen.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

As Applicants indicated in the Remarks on page 8, should the Examiner determine that new added claims are subject to a double patenting rejection, Applicants will consider filing a Terminal Disclaimer. It is suggested to do so in order to overcome the above rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45-49 are is rejected under 35 U.S.C. 102(b) as being clearly anticipated by De Faria-Correa et al (US 5,533,496). De Faria-Correa et al shows all features as claimed including an endoscopic device (Figure 3A) comprising an endoscope body or cannula (27) having proximal and distal ends and at least two lumens (34,36)for

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receiving surgical instruments (i.e., leads, cables, tools), an extension arm or elongated endoscope tube (30) passing through one of the lumens (36) in the endoscope body (27) to the distal end of the endoscope body (27), a vision head (1) attached to a distal end of the extension arm or endoscope tube (30) and configured to extend away from the distal end of the endoscope body to permit retrograde vision, wherein the head (1) includes at least a viewing tip (31) or light source, a viewing window (2), and a plurality of vision chips (column 3, line 65) for obtaining an image of a surgical site.

Claim 45 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thompson (US 5,762,603). Thompson shows an endoscopic device comprising an endoscope body 1 including at least two lumens (7,9, 29) and having proximal and distal ends, an extension arm 29 passing through one lumen in the endoscope body to the distal end of the endoscope body, a vision head 5 attached to a distal end of the extension arm 29 to permit retrograde vision, wherein the head 5 includes at least a vision chip or image sensor capable of receiving or obtaining an image of a surgical site.

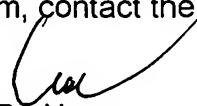
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Ba Hoang whose telephone number is (571) 272-4780. The examiner can normally be reached on Mon-fri from 8:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on (571) 272-4777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tu Ba Hoang
Primary Examiner
Art Unit 3742

May 26, 2005